

Notice of Allowability

Application No.

09/988,042

Examiner

Rebecca L Anderson

Applicant(s)

MIYATA ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 30 October 2003.
2. ☒ The allowed claim(s) is/are 1-8 and 14. (now 1-9).
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>1114</u> |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

DETAILED ACTION

Claims 1-8 and 14 are currently pending in the instant application, are allowable over the prior art of record and have been renumbered as claims 1-9. Claim 4 has been amended by the following Examiner's Amendment to delete the first named compound, 3-diphenylmethyl-7a-ethoxy-6-methyl-4H-pyrano[3,2-d]-oxazol-2(3H)-one, because the substituent containing R3, the 7a-ethoxy, is not within the scope of the parent claim 1 wherein R3 must be methyl because the value for R3 in the first named compound of claim 4 is ethyl.

EXAMINER'S AMENDMENT

An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. The transmittal form filed October 10, 2003 authorized the charge of additional extension of time fees. The required extension of time is for a total of 3 MONTH(S) and \$110.00 has already been charged for a 1 month extension of time, so the Director is authorized to charge Deposit Account No. 02-2448 an additional \$820.00 to total the required fee of \$930.00 for a 3 MONTH extension of time. Authorization for the following examiner's amendment was given in a telephone interview with David Murphy on 14 November 2003. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

A. Amend claim 4 to read as follows:

4. The 7a-alkoxy-4H-pyrano [3,2-d]-oxazol-2(3H)-one according to claim 1, wherein the 7a-alkoxy-4H-pyrano [3,2-d]-oxazol-2(3H)-one represented by the formula (I) is at least one compound selected from the group consisting of:

3-diphenylmethyl-7a-methoxy-6-methyl-4H-pyrano [3,2-d]-oxazol-2(3H)-one;

3-diphenylmethyl-3a-methyl-7a-methoxy-6-methyl-4H-pyrano [3,2-d]-oxazol-2(3H)-one;

3-(1-phenylethyl)-7a-methoxy-6-methyl-4H-pyrano [3,2-d]-oxazol-2(3H)-one;

3-benzyl-7a-methoxy-6-methyl-4H-pyrano [3,2-d]-oxazol-2(3H)-one
and

3-(1-(1-naphthyl)ethyl)-7a-methoxy-6-methyl-4H-pyrano [3,2-d]-oxazol-2(3H)-one.

B. Cancel claim 10.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance. This invention relates to products and processes for the preparation of the compound of formula (I) wherein R3 and R4 are each methyl. The closest prior art of record, EP 1000937, which discloses a process for producing 4-alkoxycarbonyl-2-oxazolidinone by reacting a 5-alkoxy-2(3H)oxazolone compound which is a reactant in the current claimed process to produce the instantly claimed invention, fails to teach or suggest the compounds of

the formula (I) wherein R3 and R4 are methyl and fails to provide motivation to prepare the instantly claimed invention. The compounds of formula (I) wherein R3 and R4 are each methyl have utility as being intermediates for the preparation of 5-methyproline methyl ester, which has a specific utility as found in EP 0 618 926.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 6:00AM to 2:30PM.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.



Rebecca Anderson
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for 

Joseph McKane
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Art Unit 1626, Group 1620